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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,004	06/24/2003	Richard C. Horian	7244-108	5737

167 7590 02/09/2005

FULBRIGHT AND JAWORSKI L L P
PATENT DOCKETING 29TH FLOOR
865 SOUTH FIGUEROA STREET
LOS ANGELES, CA 900172576

EXAMINER

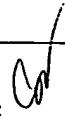
PATEL, NIHIR B

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/606,004	Applicant(s) HORIAN, RICHARD C. 	
	Examiner Nihir Patel	Art Unit 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 3rd, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 4-6, 13, 20-24 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-12, 14-19, 25 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>06.24.2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 25 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Referring to claim 1, the applicant claims a plurality of at least four cylindrical tubes having a length to width ratio of no more than one (not shown in drawings), the plurality of tubes being in two substantially identical sets (figure 9 shows only one set not two), each set including tubes varying uniformly in major cross-sectional dimension from about approximately 0.375 inches o.d. to about approximately 0.75 inches o.d. (The applicant is not clear, is the applicant referring to each set varying substantially uniformly in major cross-sectional dimension or each individual tubes varying substantially uniformly in major dimension).

Referring to claim 25, the applicant claims selecting one from a plurality of tubes of different diameter each having a length to width ratio of no more than one; inserting the one tube into a nasal passage (The applicant is no clear, is the applicant referring to selecting one set from a plurality of sets or one tube from a plurality of tubes different diameter each having a length to width ratio of no more than one; is the applicant inserting the set into the nasal passages or inserting the one tube into the nasal passage).

Referring to claim 27, the applicant claims each tube including a differential in compressive stress (the applicant is not clear, is the applicant referring to each set having a differential in compressive stress).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller US Patent No. 6,386,197 in view of Bovender US Patent No. 4,052,983. Referring to claims 1 and 25, Miller discloses the applicant's invention as claimed with the exception of providing a set of cylindrical tubes. Bovender discloses a nasal filter that does provide a set of cylindrical tubes (see figure 1). Therefore it would have been obvious to modify Miller's invention by providing a set of cylindrical tubes in order to eliminate snoring as taught in Bovender.

Referring to claims 1, 12, 14, 15 and 25, since the applicant has not provided any criticality in the specification on why the plurality of cylindrical tubes must have a length to width ratio of no more than one and why the tubes must vary substantially uniform in major cross-sectional dimension from about 0.375 to about 0.75 o.d. and based on Us Patent No. 6,386,196 (see column 3 lines 30-45), the examiner has come to a conclusion that the size of the cylindrical tubes are simply a matter of design choice and it would have been obvious to have used applicant's claimed length to width ratio or any other ratio that would be suitable to a particular patient.

Referring to claims 2 and 14, Miller discloses the applicant's invention as claimed with the exception of providing tubes that includes an outwardly extending rim at one end about the periphery of the tube. Bovender discloses a nasal filter that does provide tubes that includes an outwardly extending rim 21 at one end about the periphery of the tube (see figure 2). Therefore it would have been obvious to modify Miller's invention by providing tubes that includes an outwardly extending rim at one end about the periphery of the tube in order to eliminate snoring as taught in Bovender.

Referring to claims 7, 15 and 27, the applicant claims that each tube of the plurality of tubes includes a differential in compressive stress to strain ratio angularly about the cylindrical tube with the maximum ratio and minimum ratio being at about 90 degrees to one another. However, since the applicant has not provided any criticality on why each tube of the plurality of tubes must include a differential in compressive stress to strain ratio angularly about the cylindrical tube with the maximum ratio and minimum ratio being at about 90 degrees to one another in the specification, the examiner came to a conclusion that it simply a matter of obvious design choice and it would have been obvious to have used applicant's claimed maximum and minimum ratio or any other ratio that would be suitable to a particular patient.

Claims 3, 8, 9, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller US Patent No. 6,386,197 in view of Mercurio US Patent No. 3,457,917. Miller discloses the applicant's invention as claimed with the exception of providing a tube that includes a tab extending substantially parallel to the axial direction of the cylindrical tube from one end thereof. Mercurio discloses a nasal filtering device that does provide a tube that includes a tab 34 extending substantially parallel to the axial direction of the cylindrical tube from one end thereof.

Therefore it would have been obvious to modify Miller's invention by providing a tube that includes a tab extending substantially parallel to the axial direction of the cylindrical tube from one end thereof in order to make it easier to remove the filter.

Claims 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller US Patent No. 6,386,197 in view of Wang US Patent No. 5,417,205. Miller discloses the applicant's invention as claimed with the exception of providing each tube of the plurality of tubes that includes a diametrically extending septum. Wang discloses an air filter for the nose that does provide each tube of the plurality of tubes that includes a diametrically extending septum 11 (see figure 1; even though Wang states that 11 is a rib in a broad definition rib 11 in Wang can be defined as a septum). Therefore it would have been obvious to modify Miller's invention by providing each tube of the plurality of tubes that includes a diametrically extending septum in order to prevent snoring.

Claims 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller US Patent No. 6,386,197 in view of Wang US Patent No. 5,417,205 as applied to claims 10 and 18 above, and further in view of Mercurio US Patent No. 3,457,917. Miller discloses the applicant's invention as claimed with the exception of providing a septum that includes a tab extending substantially parallel to the axial direction of the cylindrical tube from one end thereof. Wang discloses a septum 11 (see figure 1; even though Wang states that 11 is a rib in a broad definition rib 11 in Wang can be defined as a septum) but fails to disclose a septum that includes a tab. However, Mercurio discloses a nasal filtering device that does disclose tab. Therefore it would have been obvious to modify Miller's invention by providing a septum as disclosed in Wang that includes a tab as disclosed in Mercurio that extends substantially parallel to the axial

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direction of the cylindrical tube from one end thereof in order to make the device stronger and easier to remove the nasal filter.

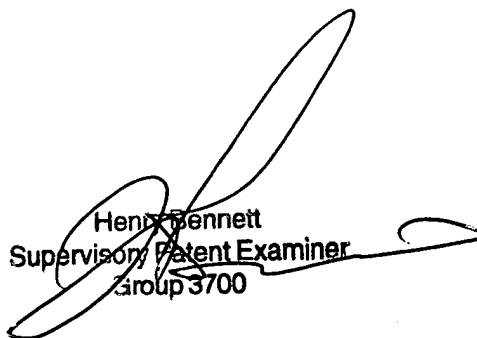
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 5,775,335 issued to Seal

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Nihir Patel whose telephone number is (571) 272-4803. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm. If attempts to reach the examiner by telephone are unsuccessful the examiner supervisor Henry Bennett can be reached at (571) 272 4791.

NP
February 3rd, 2005


Henry Bennett
Supervisory Patent Examiner
Group 3700